

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

NXP USA, INC., and NXP B.V.,

Plaintiffs,

v.

IMPINJ, INC.,

Defendant.

CASE NO. C20-1503-RSM-MAT

ORDER RE: PENDING MOTIONS

Defendant Impinj, Inc. (“Impinj”) filed a Motion for Stay (Partial) and Motion for Leave to File Amended Answer in this patent infringement matter. (Dkts. 60 & 63.) Plaintiffs NXP USA, Inc. and NXP B.V. (“NXP”) oppose the motions. (Dkts. 65 & 70.) The Court, having considered the motions, responses, and the remainder of the record, finds and ORDERS as follows:

(1) Impinj seeks a stay of plaintiffs’ claims on six of the eight patents asserted pending final resolution of petitions for *inter partes* review with the U.S. Patent and Trademark Office (PTO). (Dkt. 60.) The Court finds this request both reasonable and warranted given: (a) the significant chance it will substantially simplify the issues in this matter and streamline proceedings by reducing the claims at issue; (b) the still early stage of these proceedings, prior to the issuance of a scheduling order; and (c) an absence of undue prejudice or clear tactical disadvantage to NXP.

1 *See Pac. Bioscience Labs., Inc. v. Pretika Corp.*, 760 F. Supp. 2d 1061, 1063 (W.D. Wash. Jan.
2 10, 2011). Accordingly, Impinj's motion for a partial stay (Dkt. 60) is GRANTED, and NXP's
3 claims relating to U.S. Patent Nos. 6,680,523; 6,819,092; 7,257,092; 7,374,097; 7,538,444; and
4 7,795,951 are stayed pending resolution of Impinj's petitions for *inter partes* review before the
5 Patent Trial and Appeal Board ("PTAB").

6 (2) Impinj also seeks leave to file an amended answer pleading a license as a defense
7 to four of NXP's allegedly infringed patents and adding counterclaims that NXP has infringed
8 eight of Impinj's patents. (Dkt. 63.) The request to add the defense is appropriate in light of
9 Impinj's contention that, if found a beneficiary to a licence agreement, Impinj could not be found
10 to have infringed on four patents. *See* 35 U.S.C. § 271(a) ("whoever *without authority* makes,
11 uses, offers to sell, or sells any patented invention, within the United States or imports into the
12 United States any patented invention during the term of the patent therefor, infringes the patent")
13 (emphasis added). The Court is otherwise not persuaded by the request for leave to amend. It is
14 true that, pursuant to Federal Rule of Civil Procedure 15(a)(2), "[t]he court should freely give leave
15 [to amend] when justice so requires." However, like the judge overseeing Impinj's suit against
16 NXP currently pending in the Northern District of California, *see Impinj, Inc. v. NXP USA, Inc.*,
17 C19-3161-YGR (N.D. Cal.) (Dkt. 33), this Court has a strong interest in keeping the number of
18 patents at issue to a manageable level. Depending on the outcome of PTO proceedings, this matter
19 may require the Court's adjudication of claims associated with eight patents. There is no question
20 a doubling of the number of allegedly infringed patents would substantially increase the
21 complexity and difficulty of litigation and the Court's ability to manage this matter and resolve
22 the parties' disputes expeditiously. The Court, as such, GRANTS in part and DENIES in part
23 Impinj's Motion for Leave to File Amended Answer. (Dkt. 63.) Impinj shall file a modified

1 amended answer, consistent with the Court's rulings, within **ten (10) days** of the date of this Order.

2 (3) As previously arranged, counsel for the parties shall appear by telephone for the
3 status conference scheduled for **February 24, 2021 at 10:00 a.m.** The parties shall further, in light
4 of the Court's rulings above and no later than **February 22, 2021**, either submit a joint scheduling
5 order/discovery plan or separately submit specific proposals for the Court's consideration at the
6 status conference.

7 (4) The Clerk is directed to send a copy of this Order to the parties and to the Honorable
8 Ricardo S. Martinez.

9 DATED this 12th day of February, 2021.

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12 Mary Alice Theiler
13 United States Magistrate Judge
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